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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,715	01/28/2005	Karl Haberle	264519US0PCT	7463

22850 7590 05/31/2007
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

NOTIFICATION DATE	DELIVERY MODE
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05/31/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/522,715	Applicant(s) HABERLE ET AL.	
	Examiner Patrick D. Niland	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/9/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-15 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-15 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The withdrawal from consideration of claims 1, 5-15, and 22 as being drawn to an invention distinct from the originally presented invention is withdrawn in view of the applicant's arguments.

2. Claims 1, 5-15, and 22 are pending.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5, 6, 8-15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4663377 Hombach et al..

Hombach discloses a water dispersible isocyanate composition containing, as a preferred isocyanate, a mixture of isocyanurate of HDI and IPDI (column 2, lines 13-44, particularly 37-44) a portion of which is reacted with a compound falling within the scope of the instantly claimed emulsifier C1 (column 4, lines 6-45, particularly 6-11, 18-29, and 37-45). The resultant compound falls within the scope of the instantly claimed component C. The reaction of the IPDI isocyanurate with the component C1 is encompassed by "comprising" of the instant claims. The resultant composition falls within the scope of the instant claims. Column 4, lines 12-14 meets the instant claim 5 and lines 17-23 meet the instant claim 6. Column 5, lines 7-12 falls within

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the scope of the instant claim 8. Column 5, lines 60 et seq. falls within the scope of the instant claims 9-10. The compositions of the reference are coated onto substrates when used to adhere them to other substrates (abstract and throughout document including column 6, lines 30-35 which falls within the scope of the substrates of the instant claim 12) which falls within the scope of the instant claims 11-15.

6. Claims 1, 5-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4663377 Hombach et al. in view of US Pat. No. 6426414 Laas et al..

Hombach discloses a water dispersible isocyanate composition containing, as a preferred isocyanate, a mixture of isocyanurate of HDI and IPDI (column 2, lines 13-44, particularly 37-44) a portion of which is reacted with a compound falling within the scope of the instantly claimed emulsifier C1 (column 4, lines 6-45, particularly 6-11, 18-29, and 37-45). The resultant compound falls within the scope of the instantly claimed component C. The reaction of the IPDI isocyanurate with the component C1 is encompassed by "comprising" of the instant claims. The resultant composition falls within the scope of the instant claims. Column 4, lines 12-14 meets the instant claim 5 and lines 17-23 meet the instant claim 6. Column 5, lines 7-12 falls within the scope of the instant claim 8. Column 5, lines 60 et seq. falls within the scope of the instant claims 9-10. The compositions of the reference are coated onto substrates when used to adhere them to other substrates (abstract and throughout document including column 6, lines 30-35 which falls within the scope of the substrates of the instant claim 12) which falls within the scope of the instant claims 11-15.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the above discussed combinations of ingredients in the

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compositions of Hombach because they are encompassed by Hombach and would have been expected to give the properties described by Hombach.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the solvents of the instant claims, including claim 7, because they are known solvents for urethanes as taught by Laas, paragraph bridging columns 6-7, and are encompassed by column 5, lines 7-10 of Hombach. "Such as" is not limiting.

7. Claims 1, 5-6, 8-15, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4663377 Hombach et al. in view of US Pat. No. 6472493 Huynh-Ba.

Hombach discloses a water dispersible isocyanate composition containing, as a preferred isocyanate, a mixture of isocyanurate of HDI and IPDI (column 2, lines 13-44, particularly 37-44) a portion of which is reacted with a compound falling within the scope of the instantly claimed emulsifier C1 (column 4, lines 6-45, particularly 6-11, 18-29, and 37-45). The resultant compound falls within the scope of the instantly claimed component C. The reaction of the IPDI isocyanurate with the component C1 is encompassed by "comprising" of the instant claims. The resultant composition falls within the scope of the instant claims. Column 4, lines 12-14 meets the instant claim 5 and lines 17-23 meet the instant claim 6. Column 5, lines 7-12 falls within the scope of the instant claim 8. Column 5, lines 60 et seq. falls within the scope of the instant claims 9-10. The compositions of the reference are coated onto substrates when used to adhere them to other substrates (abstract and throughout document including column 6, lines 30-35 which falls within the scope of the substrates of the instant claim 12) which falls within the scope of the instant claims 11-15.

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It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the above discussed combinations of ingredients in the compositions of Hombach because they are encompassed by Hombach and would have been expected to give the properties described by Hombach.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the combinations of HDI and IPDI trimers of Huynh-Ba and the amounts thereof which fall within the scope of the instantly claimed amounts of these compounds of the instant claim 22 to obtain the balance of hardness and curing speed taught by Huynh-Ba and to use the amount of emulsifier falling within the scope of the instant claim 22 and Hombach (column 4, lines 5-44) that fall within the scope of the amounts of the instant claim 22 to make the aqueous dispersions of Hombach because Hombach broadly encompasses such compositions and they would have been expected to have the hardness/curing rate of Huynh-Ba, the benefits of aqueous compositions such as avoidance of harmful, EPA regulated, expensive organic solvents, and the emulsification taught by the compounds of column 4 of Hombach.

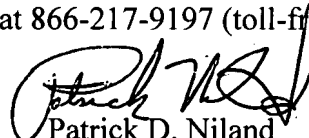
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
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